

REMARKS:

Claims 1-21 are pending in this application.

Claims 1-21 stand rejected.

Claims 1 and 9 have been amended to state “less than 20 mole percent” rather than “about 20 mole percent”. This amendment is supported by original disclosure in lines 5 and 7 of paragraph [0018].

Claims 1 and 9 have also been amended to incorporate the limitations of claim 8. Claim 8 has been cancelled.

While examination by others has no effect on the present examination, Applicant notes that the present application was allowed in Europe as EP 1,479,737.

Comments on the Response to Applicant's Arguments in the Final Office Action

The key to the present invention is that the “triarylsilyl(meth)acrylate component is present at surprisingly low levels, are useful to produce marine antifouling paints that have self polishing properties” (paragraph [0016] of the original Specification). Indeed, Applicant has found that erosion rates of 2 to 15 microns/month can be obtained with just 9 to less than 20 (as amended) mole percent.

The Examiner’s comments in the Final Rejection are:

- 1) “terpolymer”: The Gitlitz patent states that B can be “one or more copolymerizable ethylenically unsaturated monomers” (col 4, lines 8 and 9) – yet claims only a copolymer where “B Is the residue of an ethylenically unsaturated monomer”, and exemplifies only copolymers. Applicant has found that a terpolymer is needed to produce the required erosion rate at a low level of triarylsilyl(meth)acrylate.
- 2) “9 to less than 20 mole percent”: Claim 8 (and col. 5, lines 32-37) of Gitlitz states a 10-80 mole percent of organosilyl comonomer.
  - a) First this rate is for a comonomer and not a termonomer.
  - b) Second, the rate in Gitlitz applies to All organosilyl monomers, and not to the specific triarylsilyl(meth)acrylate of Applicant’s claims. Indeed, no triarylsilyl-monomers are exemplified in Gitlitz. The only trend that can be seen in the

Gitlitz data, is that a lower mole percent of some copolymer (never a terpolymer and never a triarylsilyl) gives a lower hydrolysis rate.

- c) Third, while a general mole percent level is very wide to cover all types (straight alkyl, branched alkyl or phenol, and mono-, di-, or tri) silyl groups, there is no teaching or suggestion in the Gitlitz reference as to the mole percentage range that would apply to a tri-arylsilyl- monomer.
- d) All Examples in Gitlitz involve 20 mol percent or more – clearly outside of Applicant's claims – therefore all Examples in Gitlitz teach away from Applicant's claims.

Therefore there is no teaching or suggestion for one of skill in the art in the Gitlitz reference to combine a tri-arylsilyl- monomer, as a terpolymer, at a level of less than 20 mole percent. The Gitlitz reference makes mention of each of these 3 components of Applicant's claims – but always in reference to a large group, and never to specifically combine any 2 claim limitations, much less all three.

In view of the above, the Applicant believes that the reasons for rejection have been overcome, and the claims, as amended herein, should be allowable to the Applicant. Accordingly, reconsideration and allowance are requested.

Respectfully submitted,

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